REMARKS

Claims 1 and 4-11 are pending in the application.

Claims 2-3 are cancelled from the application above without prejudice.

Independent claims 1, 8 and 11 are amended above to more clearly set forth what the Applicant regards as the invention.

Claims 3 and 9-10 have been amended to correct their dependency and/or to correct typographical errors.

No new matter has been added to the application by way of these claim amendments.

I. TRAVERSE OF THE ANTICIPATION REJECTION

The examiner rejected all claims except for claims 3-4 for being anticipated by Davies (USP 5,582,924).

The examiner's anticipation rejection is moot. The Applicant has amended independent claims 1, 8 and 11 to include the features of claims 2 and 3. Claims 2 and 3 have, accordingly, been cancelled from the application without prejudice.

II. TRAVERSE OF THE OBVIOUSNESS REJECTION

The examiner rejected claims 3-4 as being unpatentable over Davies in view Chou et al. (USP 5,322,751). As noted above, independent claims 1, 8 and 11 have been amended to include the features of claim 3. Therefore, the examiner's rejection will be discussed in the context of pending independent claims 1, 8 and 11.

Claims 1, 8 and 11 have been amended to specify that the pattern in which the magnetic material – or soft magnetic material in the case of claims 8 and 11 – is electrolessly deposited on to the substrate of the tag is defined by the prior application, by a print transfer mechanism, of a deposition promoting material which facilitates the deposition of the magnetic material from an electroless deposition solution onto areas of the substrate to which the deposition promoting material is applied. The use of a deposition promoting material is discussed in the specification for example at the second paragraph on page 3 and in the final paragraph on page 5.

It is the examiner's position that Davies discloses all of the features of the rejected claims 3-4 except that it does not disclose the application of deposition promoting materials by print transfer mechanisms including ink jets. The examiner relies upon the Chou et al. teaching of

transferring metallic coatings using printing techniques and electroless plating solutions to supply the missing Davies teaching. The examiner concludes that it would be obvious to one skilled in the art to use the methods of Chou et al. in the Davies invention in order to apply a second metallic coating.

The examiner has not established a *prima facie* case of obviousness and all claims must be allowed over the prior art. All the pending independent application claims are directed to magnetic tags and methods for their preparation that include using a substrate that includes a prior applied deposition promoting material and thereafter depositing magnetic materials onto the deposition promoting material. The examiner's obviousness rejection is deficient because the examiner has not established that the cited prior art discloses (1) a substrate including a deposition promoting material; or (2) applying a magnetic material onto the substrate including a deposition promoting material by printing techniques or mechanisms. Indeed neither Davies nor Chou et al. disclose these claim features. Davies does not discuss deposition promoting materials at all. Instead, Davies discloses applying a mask onto the substrate prior to subsequent material deposition. The mask is applied to the substrate in order to prevent adhesion of subsequently applied metals to masked areas of the substrate. This is completely opposite to the process of the present invention where the deposition promoting material is printed onto the substrate in order to promote the adhesion of the subsequently deposited materials onto the deposition promoting materials.

Chou et al. does not supply the missing Davies teachings. Chou et al. relates to applying metal coatings to substrates using electrophoretically deposited coatings. A list of the substrates to which the Chou et al. invention may be applied appears in column 17, lines 28-38. However, there is no disclosure or suggestion in Chou et al. that the methods can be applied to magnetic tags. Indeed, the passage of Chou et al. highlighted by the examiner refers to a thermal mask transfer printing technique and electroless plating performed in either order. It would not have been obvious to one skilled in the art at the time of the invention to use either method of Chou et al. to print a deposition promoting material onto the substrate of Davies to define a pattern for electroless deposition for information on a magnetic tag as claimed in the present application. Moreover, the combination of Davies and Chou et al. would not result in the claimed invention because the Chou et al. plating materials would not be applied to adhesion promoting material. Instead, the materials would be applied and only remain on the substrate portion that would not

include the mask material. For these reasons all pending claims are nonobvious over the cited prior art.

III. THE CHOU ET AL. REFERENCE

The examiner's Notice of References cited did not include a listing of the Chou et al. reference. The applicants ask the examiner to make the Chou et al. reference part of the record for this case by identifying the reference in a Notice of Reference cited.

CONCLUSION

Claims 1 and 4-11 are amended above in a manner that is believed to cause them to be patentable over the prior art of record. Favorable reconsideration and allowance of all pending application claims is, therefore, courteously solicited.

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